REMARKS

The Examiner has rejected claims 1-16 (actually claims 1-13 and 15, claims 14 and 16 having been cancelled) under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,064,380 to Swenson et al.

The Swenson et al. patent discloses bookmark for multi-media content, in which an apparatus arranged to playback a multi-media file, stores the position at which the playing back of the file was stopped thereby enabling a user to return to the stopped position when desired.

As noted in MPEP §2131, it is well founded that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 claims "An apparatus for recording comprising:

means for receiving a source signal having associated first play time information;

means for generating a recording signal from the source signal, the recording signal comprising at least a portion of the source signal including a recording discontinuity with respect to the source signal;

means for generating second time information for the recording signal in response to the first play time information and the recording discontinuity; and

storage means for storing the recording signal together with the second time information."

The Examiner has indicated that Swenson et al. discloses all of the limitations in independent claims 1 and 13, as well as in the dependent claims. In particular, the Examiner states "Swenson et al. discloses an apparatus for recording comprising: means for receiving a source signal having associated first play time information; means for generating a recording signal from the source signal **(column 1 lines 65-67 and column 5 lines 44-51)**".

Applicants submit that the Examiner is mistaken. In particular, Swenson et al., at col. 1, line 56-67, states:

> "In modern networks, the availability and use of multimedia files is increasing. Multimedia files include, inter alia, audio files and video files. Typically, a user may select or "click-on" a graphic or hypertext area on a selection screen to have the selected audio or video file presented at the user terminal by a player device. The present example will demonstrate the disclosed methodology relative to a video file although it is understood that corresponding methodology also applies to audio and other multimedia file presentations. Multimedia files are of varying length and may require from seconds to hours or longer to play through to the end of the file."

It should be apparent from the above that Swenson et al., at lines 65-67 (last 3 lines above), is merely describing the characteristics of multimedia files. However, when the opening portion of the paragraph is read, it should be clear that Swenson et al. is describing the selection, downloading and playing of a

multimedia file. Further, there is no disclosure or suggestion that the source signal has "associated first play time information".

Further, Swenson et al., at col. 5, lines 44-51, states:

> "Next, the position of the multimedia file at which the presentation was terminated is determined 421 and that position is saved in persistent memory or storage 425. The position may be determined in terms of byte position or time position or other criterion, but in any case, the position indicia stored will be sufficient to efficiently return to the position within the multimedia file at which the play was terminated."

This portion of Swenson et al. describes the storing of a position indicator indicating the position in the multimedia file that presentation (playback) was terminated. However, there is no disclosure or suggestion of generating a recording signal from the source signal.

The Examiner further indicates that Swenson et al. discloses "the recording signal comprising at least a portion of the source signal including a recording discontinuity with respect to the source signal **(column 1 lines 65-67 and column 4 lines 62-67)**".

Again, Applicants submit that the Examiner is mistaken. In particular, Swenson et al., at col. 4, lines 62-67, states:

> "If a user clicks on the "Stop Without Saving" selection, any video or multimedia file being played will be stopped and the program will not save the position at which the file was stopped. However, if a user click on the "Stop & Save Position" button, the file being played will be stopped and the position at which the file was stopped will be saved to..."

This portion of Swenson et al. describes whether or not the position indicator is saved. However, there is no disclosure or

suggestion of generating a recording signal, and the recording signal "comprising at least a portion of the source signal including a recording discontinuity with respect to the source signal". It should be noted that a "recording discontinuity" is described in the subject specification on page 8, lines 9-16. Based on this description, a "recording discontinuity" is more than the mere ceasing of playback of a multimedia file.

Furthermore, the Examiner indicates that Swenson et al. discloses "means for generating second time information for the recording signal in response to the first play time information and the recording discontinuity **(column 4 line 62 to column 5 line 22)**."

This portion of Swenson et al. states:

> "If a user clicks on the "Stop Without Saving" selection, any video or multimedia file being played will be stopped and the program will not save the position at which the file was stopped. However, if a user click on the "Stop & Save Position" button, the file being played will be stopped and the position at which the file was stopped will be saved to persistent memory such the user's disk drive or in a data file associated with the user's browser program and stored on the user's hard drive. The position at which the multimedia presentation was terminated may also be transferred to the server or other persistent memory location for storage in persistent memory associated with the multimedia file or with other user data. A user may also selectively designate a custom name for the saved file by inputting in the "Title To Save" input area on the display screen. In any case, the position in the multimedia file at which the presentation was stopped represents the position at which a subsequent request to play the particular multimedia file will be initiated. The subsequent start position may also include a rewind of a predetermined or selectable length from the previously terminated position in order to refresh the user with the latter portion of the previously viewed video or other

multimedia file. The saved "Title", along with other and previously saved files and file segments, may be listed in the "Multimedia Files" section of the screen display as in a typical "bookmark" function. A user may select one of the multimedia files from the "Multimedia Files" screen area to initiate the playing of the selected multimedia file from the previously saved position at which the file was last terminated."

This portion of Swenson et al. describes the position indicator to be stored, and that the position indicator may indicate the exact position at which the multimedia file was previously stopped, or may alternatively indicate a position rewound a predetermined amount of time from the actual stopped position of the multimedia file. However, there is no disclosure or suggestion that this position indicator is generated "in response to the first play time information and the recording discontinuity".

Finally, the Examiner indicates that Swenson et al. discloses "storage means for storing the recording signal together with the second time information (column 4 line 62 to column 5 lines 22).

Applicants submit there is no disclosure or suggestion in Swenson et al. for storing the recording signal along with the second time information. Rather, merely states that the position information may be stored locally (at the user's site), or alternatively, may be stored at the server where the original multimedia file is stored. However, there is no disclosure or suggestion of storing a recording signal with the second time information.

In the subject invention as described in the specification on page 7, line 28, to page 8, line 18, the recording controller 203 receives the source signal and generates a recording signal for storage in the storage medium 205. This recording signal comprises at least a portion of the source signal including a recording discontinuity with respect to the source signal, and is recorded along with the second time information on the storage medium 205

Applicants therefore submit that there is no disclosure or suggestion in Swenson et al. of "means for generating a recorded signal from the source signal, the recorded signal comprising at least a portion of the source signal including a recording discontinuity with respect to the source signal".

In view of the above, Applicants believe that the subject invention, as claimed, is neither anticipated nor rendered obvious by the prior art, and as such, is patentable thereover.

Applicants believe that this application, containing claims 1-13 and 15, is now in condition for allowance and such action is respectfully requested.

Respectfully submitted,

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